

**REMARKS/ARGUMENTS**

This amendment is submitted in response to the Office Action dated June 24, 2005. Reconsideration and allowance are requested.

Claims 21-24 remain in this application. Claims 1-20 were previously canceled.

***Claim Rejection Under 35 USC 103***

In the Office Action, claim 21 was rejected under 35 USC 103(a), as being unpatentable over Yoshiaki (JP 63-297949) in view of Redmond (U.S. Patent Number 4,246,753). The counsel for assignee respectfully traverses.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2143. The counsel for assignee respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

Yoshiaki or Redmond, either individually or when combined, do not teach all of the limitations of claim 21. The Examiner acknowledged that Yoshiaki does not explicitly disclose the details of the generator assembly but rejected claim 21 by combining Redmond with Yoshiaki and arguing that Redmond discloses a waterwheel and inverter in the assembly in the same field of the endeavor for the purposes of generating electricity. Counsel for assignee vigorously traverses because Redmond does not teach an inverter as claimed. In fact there is no mention of an inverter, as claimed, anywhere in Redmond. Since an inverter, as claimed, is not taught or suggested by Yoshiaki or Redmond, claim 21 is not obvious under *In re Vaeck*.

Nevertheless, and in an effort to expedite prosecution, claim 21 has been *further* amended to include "an inverter controlling said AC electric power generator for converting said

AC electric power generated by said AC electric power generator to AC electric power of a desired voltage and a desired frequency." Counsel for assignee believes that the amended claims are not obvious under In re Vaeck because Yoshiaki and Redmond, either individually or when combined, do not teach all of the claimed limitations. Therefore, counsel respectfully requests that the Examiner reconsider the rejection in light of the amendment to the claims and the remarks.

### ***Double Patenting***

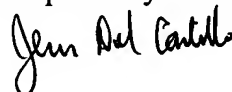
In the Office Action, claims 21-24 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 9 of U.S. Patent No. 6,698,223 in view of Yoshiaki (JP 63-297949). Counsel believes that in light of these amendments, claims 21-24 should not be rejected under the judicially created doctrine of obviousness-type double patenting because at least the limitation of "an inverter controlling said AC electric power generator for converting said AC electric power generated by said AC electric power generator to AC electric power of a desired voltage and a desired frequency" is not obvious. Counsel for assignee respectfully requests that the Examiner withdraw this rejection under the judicially created doctrine of obviousness-type double patenting and allow the claims.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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